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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MORAN, MARJORIE A

ART UNIT PAPER NUMBER

1631

DATE MAILED: 04/23/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/637,086

Applicant(s)

FINCHER ET AL.

Examiner

Marjorie Moran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 2-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Election/Restrictions

Applicant's election with traverse of Group I, claim 1, and SEQ ID NO: 1 in Paper No. 8, filed 1/9/02 is acknowledged. The traversal is on the ground(s) that a search for all groups and for more than one SEQ ID NO would not be an undue burden. This is not found persuasive because a search for a protein or a plant is a different search than for a nucleotide sequence and requires a search of different databases. The results from a search for a nucleic acid sequence, for example, would not be expected to necessarily include results pertaining to plants or proteins. In addition, and specifically with regard to a search for more than a single sequence, it is noted that a search for any Group or sequence requires a search of both nonpatent literature and foreign patents, as well as a search of US patents, therefore the examiner maintains that a search for more than one Group or sequence would be an undue burden. As previously set forth in the restriction requirement of 12/3/01, due to the increasingly large size of sequence databases which must be searched and the increasing numbers of applications requiring sequence searches, it creates an undue burden on the Office to search more than a single sequence (product) per application. For these reasons, the requirements of 37 CFR 1.141 et seq. are no longer waived and applicant is required to elect a single sequence for examination.

The requirement is still deemed proper and is therefore made FINAL.

Claims 2-9 and all sequences other than SEQ ID NO: 1 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected Inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8.

An action on the merits of elected claim 1, as it reads on elected SEQ ID NO: 1, follows.

Specification

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. In particular, see pages 5 and 28 of the instant specification. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

35 U.S.C. 101/112 Utility Rejections

The pending claims have been reviewed in light of the Utility Examination Guidelines and Guidelines for Examination of Patent Applications under 35 U.S.C. 112, first paragraph, Written Description Requirement, Federal Register, Vol. 66, No. 4, pages 1092-1111, Friday, January 5, 2001.

The examiner is using the following definitions in evaluating the claims for utility.

"Specific" - A utility that is *specific* to the subject matter claimed. This contrasts with a *general* utility that would be applicable to the broad class of the invention.

"Substantial" - A utility that defines a "real world" use. Utilities that require or constitute carrying out further research to identify or reasonably confirm a "real world" context of use are not substantial utilities.

"Credible" - Credibility is assessed from the perspective of one of ordinary skill in the art in view of the disclosure and any other evidence of record that is probative of the applicant's assertions. That is, the assertion is an inherently unbelievable undertaking or involves implausible scientific principles.

"Well-established" - a specific, substantial, and credible utility which is well known, immediately apparent, or implied by the specification's disclosure of the properties of a material, alone or taken with the knowledge of one skilled in the art.

35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

Claim 1 is rejected under 35 U.S.C. § 101 because the claimed invention lacks patentable utility due to its not being supported by a specific, substantial, and credible utility or, in the alternative, a well-established utility.

The claimed subject matter is not supported by a specific, substantial, and credible utility because the disclosed uses are generally applicable to broad classes of this subject matter. In addition, further characterization of the claimed subject matter would be required to identify or reasonably confirm a "real world" use. The examiner does not find an adequate nexus between the evidence of record and the asserted properties of the claimed subject matter.

The specification discloses a variety of uses for nucleic acids on pages 11-13 including determining the association of polymorphisms and a plant trait, use in hybridization assays, measurement of protein expression/levels, detecting mutations, modifying protein expression, and use as molecular tags. The specification also discloses, on pages 28-30 and 45-50, uses for nucleic acids including isolation of genes, detection of other nucleic acid molecules, determining an Expression Response, and genetic mapping. These are non-specific uses that are applicable to nucleic acids in general and not particular or specific to the nucleic acids being claimed. The specification discloses on pages 33-42 that various libraries/clones are associated with various cotton plant tissues, and can thus be used to "enable" the acquisition of a variety of genes, but does not disclose anywhere an association between a specific gene and SEQ ID NO: 1. The sequence listing discloses that SEQ ID NO: 1 is from clone LIB3083. Page 33 of the specification discloses that this clone was isolated from young plant boll tissue. However, merely because a sequence is found in a library from a particular tissue is not evidence that the sequence is specific to that tissue or a particular stage of growth. The specification does not disclose subtractive assays, or any other evidence that SEQ ID NO: 1 is specific to boll tissue and/or to a specific growth or developmental stage of cotton plants. The

specification does not disclose an association of any kind between elected SEQ ID NO: 1 and a particular plant trait, mutation, or differential expression of any nucleic acid or protein encoded thereby.

A nucleic acid may have utility where it encodes a protein which itself has a specific, substantial, and credible utility, or a well-established utility. For example, insulin has a well-established utility, therefore a nucleic acid encoding insulin has utility. The instant specification discloses on page 1 that the instantly claimed nucleic acids encode cotton proteins, but is silent with respect to specific proteins encoded and any utilities the encoded proteins may have. The specification does not disclose that the claimed nucleic acids actually encode a protein with any known activity or function, nor does the specification disclose an open reading (ORF) or other evidence that SEQ ID NO: 1 does, in fact, encode a functional protein of any kind. SEQ ID NO: 1 comprises at least two putative start codons (ATG's), but it is unknown which of these represents the start of an ORF, or if the peptide expressed from either putative ORF is functional, or has a well-known utility.

Applicant should explicitly identify a specific, substantial, and credible utility for the claimed invention and establish a probative relation between any evidence of record and the originally disclosed properties of the claimed invention.

Claim 1 is also rejected under 35 U.S.C. § 112, first paragraph. Specifically, since the claimed invention is not supported by a specific, substantial, and credible utility or a well-established utility for the reasons set forth above, one skilled in the art would not know how to use the claimed invention

35 U.S.C. 112, Written Description Rejection

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification discloses SEQ ID NO: 1 which putatively encodes a cotton protein. Claim 1 recites open claim language (comprising) and is thus directed to encompass gene sequences, sequences which hybridize, allelic variants, homologues, and so forth, as set forth on pages 20-22 of the specification. While the specific sequences represented by SEQ ID NO: 1 meet the written description provision of 35 USC 112, first paragraph, none of the other sequences also encompassed by claim 1 do so. The specification provides insufficient written description to support the genus encompassed by the claim.

Vas-Cath Inc. v. Mahurkar, 19 USPQ2d 1111, makes clear that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed*." (See page 1117.) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See Vas-Cath at page 1116.)

The skilled artisan cannot envision the detailed chemical structure of the encompassed polynucleotides, regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it. The nucleic acid itself is required. See Fiers v. Revel, 25 USPQ2d 1601, 1606 (CAFC 1993) and Amgen Inc. V. Chugai Pharmaceutical Co. Ltd., 18 USPQ2d 1016. In Fiddes v. Baird, 30 USPQ2d 1481, 1483, claims directed to mammalian FGF's were found unpatentable due to lack of written description for the broad class. The specification provided only the bovine sequence.

Finally, University of California v. Eli Lilly and Co., 43 USPQ2d 1398, 1404, 1405 held that:

...To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention." Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997); In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) ("[T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is

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claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966.

An adequate written description of a DNA, such as the cDNA of the recombinant plasmids and microorganisms of the '525 patent, "requires a precise definition, such as by structure, formula, chemical name, or physical properties," not a mere wish or plan for obtaining the claimed chemical invention. *Fiers v. Revel*, 984 F.2d 1164, 1171, 25 USPQ2d 1601, 1606 (Fed. Cir. 1993). Accordingly, "an adequate written description of a DNA requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it; what is required is a description of the DNA itself." *Id.* at 1170, 25 USPQ2d at 1606.

The name cDNA is not itself a written description of that DNA; it conveys no distinguishing information concerning its identity. While the example provides a process for obtaining human insulin-encoding cDNA, there is no further information in the patent pertaining to that cDNA's relevant structural or physical characteristics; in other words, it thus does not describe human insulin cDNA. Describing a method of preparing a cDNA or even describing the protein that the cDNA encodes, as the example does, does not necessarily describe the cDNA itself. No sequence information indicating which nucleotides constitute human cDNA appears in the patent, as appears for rat cDNA in Example 5 of the patent. Accordingly, the specification does not provide a written description of the invention of claim 5.

Therefore, while the exact sequence represented by SEQ ID NO: 1 is fully described by the specification, none of the other sequences encompassed by the claim meets the written description provision of 35 USC 112, first paragraph. The species specifically disclosed are not representative of the genus because the genus is highly variant. Applicant is reminded that Vas-Cath makes clear that the written description provision of 35 USC 112 is severable from its enablement provision. (See page 1115.)

Conclusion

Claim 1 is rejected; claims 2-9 are withdrawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marjorie A. Moran whose telephone number is (703) 305-2363. The examiner can normally be reached on Monday to Friday, 7:30 am to 4 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (703) 308-4028. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to a patent analyst, Tina Plunkett, whose telephone number is (703) 305-3524.



Marjorie A. Moran
Examiner
Art Unit 1631

April 21, 2002